

REMARKS

With this amendment, Applicant rewrites claim 1 to include the subject matter of pending claim 15. The amendment should be entered because the subject matter was previously before the Examiner and therefore, no new issues are raised. Moreover, Applicant respectfully submits that the finality of the rejection is improper.

I. Improper Finality

Applicants submit that the Examiner has fundamentally changed the analysis of Sugaya (U.S. Patent No. 6,714,313). The Examiner now contends that RAM 306 corresponds to the claimed storage medium. Applicants' response in the filing of April 26, 2006, was based on the Examiner's prior analysis that external memory 317 allegedly corresponds to the claimed storage medium.

It appears the Examiner is in agreement with Applicants that external memory 317 does not correspond to the claimed storage medium. However, rather than issue a non-final office action, the Examiner has "reinterpreted" Sugaya and has issued a final office action.

In telephonic communication with Applicants' representative on August 21, 2006, the Examiner acknowledged that such a shift in the analysis coupled with a final rejection is unfair to Applicants. Therefore, Applicants respectfully request that the finality of this office action be withdrawn and the amendments in the current response be entered as a matter of right.

II. Claim Rejections - 35 USC § 102

The Examiner has rejected claims 1-5 and 15 under 35 U.S.C. § 102(e) as being anticipated by Sugaya (U.S. Patent No. 6,714,313) ["Sugaya"]. For at least the following reasons, Applicants traverse the rejection.

Claim 1 has been amended to incorporate the subject matter of claim 15.

Claim 15 recites an image outputting apparatus that comprises "a holder for accepting the storage medium [in which a plurality of the images are recorded and also storing additional information of the respective images], wherein the storage medium is a detachable medium." The Examiner contends that the features related to external memory 317 correspond to the claimed features.

In telephonic communication on August 21, Applicants' representative requested further clarification since, in claim 1, the Examiner contends that the claimed storage medium corresponds to RAM 306 of Sugaya, and, in claim 15, the Examiner appears to contend that the claimed storage medium corresponds to external memory 317.

In response, the Examiner contends that the language in dependent claim 15 does not necessarily indicate that the storage medium in claim 15 is the same storage medium as in independent claim 1. However, the Examiner indicated that if the storage medium is the same, then claim 15 would not read on the prior art.

Applicants submit that the claim language clearly recites "a holder for accepting the storage medium." The antecedent basis is provided earlier in the claim, which reads "a storage medium in which a plurality of the images are recorded." Accordingly, contrary to the

Examiner's contentions, the claimed language clearly recites that the storage medium in which a plurality of images are recorded is also the storage medium that is detachable. Since the Examiner has conceded that Sugaya does not disclose this feature, Applicant submits that claim 15 is patentable.

III. Claim Rejections - 35 USC § 103

The Examiner has rejected claims 6-14, 16 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Sugaya and ISO. For at least the following reasons, Applicants traverse the rejection.

Claim 6 recites an image outputting apparatus for printing an image on a recording sheet by using a storage medium in which a plurality of the images are recorded, said storage medium also storing additional information of the respective images, ... wherein said additional information is photographic information given at the time of taking said image." The Examiner concedes that Sugaya does not disclose the claimed feature but applies ISO to allegedly cure the deficiency. The Examiner contends that one skilled in the art would have been motivated to combine the teachings to "allow the images to be sorted by the original date and time when the image was taken ... [in order to ease] the burden of the user from manually sorting the image after printout." (Office Action at page 5.)

Mere "identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). "[T]here must be some **motivation, suggestion or teaching of the desirability** of making the specific combination." *Id.* (emphasis added.) Here,

there is no disclosure or suggestion in Sugaya and ISO (taken alone or in combination) of using “photographic information given at the time of taking an image” for discharging printed recording sheet to a sorting tray, let alone why substituting “user names” in the system of Sugaya with “photographic information” would be desirable.

The Examiner proffered reason, which states that the burden of manually sorting the images after printout is eased, is not found in any of the prior art, and appears to be taken from Applicants’ Specification (see page 5, lines 5-6), which is clearly improper hindsight.

Accordingly, Applicants submit that the Examiner has failed to make a *prima facie* case of obviousness for claim 6.

In addition, for at least reasons analogous to those given above with respect to claim 1, Applicants submit that modifying the system of Sugaya as suggested by the Examiner would change the principle of operation of Sugaya. Therefore, Applicants submit that the Examiner has failed to make a *prima facie* case of obviousness for claim 6 for this additional reason.

Similar to the rejection of claim 6, the Examiner’s motivation to combine Sugaya and ISO in the rejection of claims 11, 12 and 14 is not supported in the prior art and appears to be taken from Applicants’ Specification. In addition, similar to the rejection of claims 1 and 6, Applicants submit that the Examiner’s suggested modification of Sugaya with respect to the subject matter claims 11, 12 and 14 would change the principle of operation of Sugaya. Therefore, for at least reasons analogous to those given above with respect to claims 1 and 6, Applicants submit that the Examiner has not made a *prima facie* case of obviousness with respect to claims 11, 12 and 14.

Applicants submit that claims 7-10 and 13 are patentable at least by virtue of their respective dependencies.

Because ISO does not cure the deficient teachings of Sugaya given above with respect to claim 15, Applicants submit that claim 16 is patentable at least by virtue of its dependency on claim 15.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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Date: October 17, 2006